REMARKS

In this communication, Applicants have canceled Claims 1-50 and added new Claims 51-54. No new matter is introduced. Claims 51-54 are pending. Allowance of all pending claims is respectfully requested.

Rejections under 35 U.S.C. § 112

Claims 23-27 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for reasons stated on page 2-4 of the Office Action. Specifically, the Office Action alleges that the specification does not describe what constitutes a wild-type TSG101 protein with any associated function.

Claims 23-27 have been canceled. The rejection to these claims is now moot. New Claims 51-54 are directed to an antibody that binds to a TSG101 protein as set forth in SEQ ID NO:2 or SEQ ID NO:4. As admitted by the Examiner on page 4 of the Office Action, SEQ ID NOS:2 and 4 meet the written description provision of 35 U.S.C. 112, first paragraph.

Rejections under 35 U.S.C. § 103

Claims 23-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Maucuer et al (hereinafter "Maucuer") in view of Campbell and Levinson et al. (hereinafter "Levinson") for reasons stated on pages 4-5 of the Office Action. Claims 23-26 have been canceled. The rejection is now moot. Applicants respectfully submit that new Claims 51-54 are not obvious over Maucuer, Campbell and Levinson.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP § 2142. Moreover, obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art (see MPEP 2143.01 and In re Jones 21 USPQ2d 1941 (Fed. Cir. 1992)).

New Claims 51-54 are directed to an antibody that binds to a TSG101 protein as set forth in SEQ ID NO:2 or SEQ ID NO:4. Maucuer describes a 82 amino acid (aa) polypeptide (CC2) that is identical to amino acid residues 231-312 of SEQ ID NO:4 except two amino acids at position #237 and #275. Maucuer, however, does not identify the TSG101 protein, nor does it provide suggestions or any motivation to generate an antibody against the putative CC2 protein since Maucuer made no attempt to isolate and purify the protein. The CC2 polypeptide is at best an overlap fragment of TSG101. Even if we take, arguendo, the Examiner's position that the manufacture of antibodies against CC2 is *prima facie* obvious over Maucuer, there is no reason for one skilled in the art to believe that the denatured 82aa fragment could yield an antibody that would have any utility at all or that would bind to the TSG101 of SEQ ID NO:2 or 4 (381aa or 380aa, respectively). Indeed, Maucuer concludes that further characterization of the CC2 "protein" may contribute to the understanding of Stathmin.

Accordingly, Applicants respectfully submit that Maucuer, in combination with Campbell and Levinson, does not render new Claims 51-54 obvious.

CONCLUSION

Applicants respectfully submit that this application is now in condition for examination on the merits. Early notification of such action is earnestly solicited. Should the Examiner have any suggestions to place the application in even better condition for allowance, Applicants request that the Examiner contact the undersigned representative at the telephone number listed below.

Respectfully submitted,

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